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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,335	11/10/2003	Ivano Vagnoli	141483.00003-P1243US00	5137

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EXAMINER	
WATKINS III, WILLIAM P	
ART UNIT	**PAPER NUMBER**
1772	

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/705,335	VAGNOLI, IVANO	
	Examiner	Art Unit	
	William P. Watkins III	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 July 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) *9-13* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *9-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's election of Group II, claims 9-13 in the reply filed on 13 July 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. The objection to claim 11 in section 5 of the office action mailed 05 April 2005 is withdrawn in view of applicant's amendments in the response filed 13 July 2005.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liardet (U.S. 4,864,790) in view of Hirsch

(U.S. 4,849,145) and Zegler et al. (U.S. 5,567,497) further in view of Yoshimi et al. (U.S. 4,860,506).

Liardet teaches a floor tile or roll with a leather surface and a backing layer joined by adhesive (abstract, col. 9, lines 30-20). Zegler et al. teaches joining a top surface covering that has a layer which will fuse with thermoplastic to a thermoplastic base which has channels (abstract). Hirsch teaches joining thermoplastic to a leather layer by injection of the thermoplastic into holes in the leather layer and around edges of the leather layer (abstract, Figure 5). The instant invention claims a leather floor tile with a thermoplastic backing that has resin which extends through holes in the leather layer and other perforations that are not filled. It would have been obvious to join a thermoplastic as the base layer of Liardet to prevent slipping because of the teachings of Zegler et al. (U.S. 5,567,497). It further would have been obvious to have joined the leather layer and bottom resin layer by injecting resin into holes of the leather layer instead of using adhesive because of the teachings of Hirsch. It further would have been obvious to perforate the assembly of Liardet as modified above in order to provide sound reduction because of the teachings of Yoshimi et al.

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 9-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6-10 of copending Application No. 10/705,256 in view of Yoshimi et al. (U.S. 4,860,506). Although the conflicting claims are not identical, they are not patentably distinct from each other because the sister claims teach a leather floor tile with a resin layer. Yoshimi et al. teaches perforations of a floor. The instant invention claims a leather tile with a resin layer and perforations. It would have been obvious to perforate the tile of the sister application in order to provide noise reduction because of the teachings of

Yoshimi et al. Only a one way showing is needed as the applications have the same filing date.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Applicant's arguments filed 13 July 2005 have been fully considered but they are not persuasive.

Applicant argues that Liardet is not suitable for use in a heated floor system. No such system is being claimed, only a leather tile with holes suitable for room lining. The tiles of Liardet do line the floor of a room and have through holes that connect surfaces in view of the teachings of Yoshimi et al. Regarding Yoshimi et al. applicant argues that the system is for a floating floor and not a decorative face. The examiner notes that the reference teaches even the decorative cover layer being perforated (element 12, Figure 12). In any event there is no reason that a tile such as Liardet could not be used in a floating floor application. Applicant argues that Hirsch and Liardet are nonanalogous art. The examiner disagrees. Liardet is directed to leather layers and joining those layers to other substrates. Hirsch is directed to joining leather layers to

plastic layers by the use of plastic, which penetrates the leather layer. The references thus share a common problem and are therefore analogous art. Regarding Zegler, applicant argues that the reference does not teach holes or air exchange. The examiner does not rely on this reference for a teaching of holes. Hirsh is relied upon for a teaching of holes, which are filled with resin; while Yoshimi et al. is relied upon for holes that connect the upper and lower surface and allow air interchange. The motivation to combine each of the references is explicitly given in the above rejection. The examiner notes that applicant has not addressed the double patenting rejection given in the first office action and repeated above.

8. This application contains claims 1-8 drawn to an invention nonelected with traverse in the paper filed 13 July 2005. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Watkins III whose telephone number is 571-272-1503. The examiner works an increased flex time schedule, but can normally be reached Monday through Friday, 11:30 A.M. through 8:00 P.M. Eastern Time. The examiner returns all calls within one business day unless an extended absence is noted on his voice mail greeting.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR of Public PAIR. Status information for unpublished applications is available through

Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WW/ww
September 30, 2005

WILLIAM P. WATKINS III
PRIMARY EXAMINER